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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,846	12/27/2001	Tetsuya Nishimura	KPO123	8973
25271	7590	12/11/2003		
GALLAGHER & LATHROP, A PROFESSIONAL CORPORATION 601 CALIFORNIA ST SUITE 1111 SAN FRANCISCO, CA 94108			EXAMINER	
			WONG, ERICK	
			ART UNIT	PAPER NUMBER
			2874	

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/033,846	NISHIMURA, TETSUYA	
	<b>Examiner</b> Eric Wong	<b>Art Unit</b> 2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 August 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see pages 6-8, filed 8/25/2003, with respect to the rejection(s) of claim(s) 1-7 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Japanese Patent Publication 04-221912 to Masataka.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Publication 04-221912 to Masataka in view of United States Patent Number 5,383,118 to Nguyen.

As to claims 1, 2, 5, 6, 8, 9, 12, and 13, Masataka discloses in figures 1 and 3 and abstract, an optical module comprising:

- A surface light receiving or a surface light emitting type optical element mounted on a predetermined substrate (23);
- At least one spacer mounted on said substrate (15).
- An optical fiber array having a plurality of optical fibers buried therein substantially in parallel with one another with a predetermined pitch therebetween, said optical fiber array being mounted to said substrate with said

spacer interposed between the substrate and the optical fiber array such that the optical fibers are opposed to a plurality of light receiving elements or light emitting elements of the optical element mounted on the substrate respectively, and said optical fiber array being mounted to said substrate with alignment between the end surfaces of the optical fibers, the light receiving elements or light emitting elements, and the substrate carried out active or passive alignment means,

- As to claims 3-4 and 10-11, Masataka discloses the fiber array is provided with engagement means with pin like holes (holes for pins 14),
- As to claim 7, all components are bonded together after alignment,
- As to claim 12, there is a predetermined gap between the optical elements and opposing first ends of the optical fibers (Figures 2-4), but
- Masataka fails to explicitly disclose image recognition as an alignment means (Claims 1, 2, 6, 8, 13).

It is widely known in the art that passive alignment means include techniques such as image recognition as disclosed in the abstract of United States Patent Number '118 to Nguyen.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to recognize that image recognition is a widely known technique for passive alignment of devices to keep optical losses to a minimum.

***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. United States Patent Number 4,772,123 to Radner for device alignment methods using image recognition.
- b. Japanese Patent Publication Number 09-159882 to Kazuhiko et al. for a structure and method of coupling optical elements that includes a transparent spacer between a substrate and arrayed optical elements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Wong whose telephone number is 703-305-4741. The examiner can normally be reached on Monday through Friday, 830AM - 430PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on 703-308-4819. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Please note: After January 12<sup>th</sup>, 2004, Examiner's phone number will be changed to (571) 272-2363.

EW



HEMANG SANGHAVI  
PRIMARY EXAMINER